

REMARKS

Claims 2-16 are pending in this application. By this Amendment, claims 2, 9, 10 and 12-16 are amended. The amendments to the claims add no new matter as they are supported at least by the claims as originally filed. Claim 1 is canceled without prejudice to, or disclaimer of, the subject matter recited in that claim. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

Applicant appreciates the courtesies shown to Applicant's representative by Examiner Everhart in the May 3, 2005, personal interview. Applicant's separate record of the substance of the interview is incorporated into the following remarks.

I. Allowable Subject Matter

The Office Action, on page 4, indicates that claims 3-8 and 13 recite allowable subject matter. Applicant appreciates this indication of allowability. The amendments to claim 13, and to claims 14-16 as well, are undertaken based on this indication of allowability. With regard to claims 3-8, Applicant respectfully submits that claim 2, as amended, upon which these claims directly and indirectly depend, is allowable for at least the reasons set forth below.

II. Formal Matters

The Office Action, on page 2, objects to claim 15 as being of improper dependent form. Claim 15 is amended to obviate the objection. Accordingly, withdrawal of the objection to claim 15 is respectfully requested.

The Office Action, on page 2, rejects claims 10-12 under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Office Action asserts that there is insufficient antecedent basis for a feature recited in the claims. Claims 10 and 12 are amended to provide antecedent basis for the feature "the semiconductor substrate." These amendments obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claims 10-12 under 35 U.S.C. §112, second paragraph, are respectfully requested.

III. The Claims Recite Allowable Subject Matter

The Office Action, on page 2, rejects claims 1, 9 and 14-16 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,512,712 to Iwata et al. (hereinafter "Iwata"). This rejection is respectfully traversed.

The cancellation of claim 1 renders the rejection of this claim moot. Claim 9 is amended to depend from claim 2, which is not anticipated by Iwata (see page 4 of the Office Action). Claims 14-16 are amended to depend from allowable claim 13, or to recite the circuit board structure of allowable claim 13. As such, these claims are allowable to the same extent that claim 13 is allowable.

Accordingly, reconsideration and withdrawal of the rejections of claims 9 and 14-16 under 35 U.S.C. §102(b) as being anticipated by Iwata are respectfully requested.

The Office Action, on page 4, rejects claims 2 and 12 under 35 U.S.C. §103(a) as being unpatentable over Iwata and further in view of U.S. Patent No. 6,744,144 B2 to Peterson. This rejection is respectfully traversed.

The Office Action recognizes that Iwata is silent with respect to the substrate being a semiconductor wafer. The Office Action then asserts that Peterson discloses a wafer 100 with microelectronic dies on the wafer, the substrate can be made a wafer made of silicon, glass or other material, and the dies are integrated circuit dies. The Office Action then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to have used a semiconductor wafer in the device taught by Iwata because Iwata discloses that the substrate can be glass and Peterson discloses that silicon can be used instead of glass.

Applicant respectfully submits that the Patent Office has failed to make a *prima facie* case for obviousness for the following reasons.

First, Iwata teaches an improved printed wiring board having alignment marks and/or fiducial marks protected by a light transmittable insulation coating provided on each surface of a substrate having conductor circuits and indicator markings (Abstract and col. 3, lines 6-11). Iwata is directed to a printed wiring board having indications thereon that provide information such as the types or kinds of electronic devices to be mounted on the printed wiring board (col. 1, lines 9-12). The indications such as alignment marks, numbers and signs are intended to be seen through and protected by the light transmittable insulation coating. Peterson, on the other hand, teaches a method and apparatus for marking microelectronic devices, such as bare microelectronic dies and package devices to enhance the identification and automatic handling of wafers, dies and package device (Abstract). Peterson seeks to, for example, deter the proliferation of counterfeit microelectronic parts (col. 3, lines 13-14) by providing a hidden marking layer (Abstract and col. 4, lines 13-14). As such, Applicant respectfully submits that one of ordinary skill in the art would not have been motivated, given the teachings of Iwata, in which visible marks are intended to be protected, to apply the teachings of Peterson, in which identifying marks are intended to be hidden. Peterson, in fact, teaches away from Iwata in the aspects of at least a visibly definable alignment and/or fiducial mark on the face of a substrate.

Second, Applicant notes that the Office Action sets forth no reference to any specific teaching or suggestion in either of the prior art references that would have made it obvious to one of ordinary skill in the art to modify the teachings of Iwata with the teachings of Peterson to obtain a device such as is recited in at least independent claim 2.

MPEP §2143.01 instructs that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP §2143.01 further instructs that "[a]lthough a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there

must be a suggestion or motivation in the reference to do so." *See also in re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). The rejection of at least independent claim 2 is improper in view of MPEP §2144.03 because in stating the rejection the Office Action lacks the required specific evidence of a teaching, suggestion or motivation to one of ordinary skill to combine the references. Iwata disclosing that the substrate can be glass and Peterson disclosing that silicon can be used instead of glass simply is not sufficient.

Third, there is no evidence that Peterson's alleged teaching that "silicon can be used instead of glass" is applicable in any other context than the context of Peterson's device. This surely cannot be taken as a general teaching that applies in all contexts.

Fourth, neither Iwata nor Peterson recognizes a particular advantage in using glass. Seeing no advantage, one of ordinary skill in the art would not have been motivated to make the change suggested by the Office Action. In contrast, Applicant's disclosure does teach a particular advantage. The lack of recognition of an advantage in the prior art, and the presence of a teaching of an advantage in the application, combine as strong evidence that the Office Action impermissibly relies on hindsight knowledge gained from Applicant's disclosure.

As such, Applicant respectfully submits that the combination of all of the features recited in at least independent claim 2 would not have been suggested by the combination of the applied references. Additionally, claim 12 also would not have been suggested by the combination of the applied references for at least the dependence on independent claim 2 as well as for the separately patentable subject matter claim 12 recites.

Accordingly, reconsideration and withdrawal of the rejection of claims 2 and 12 under 35 U.S.C. §103(a) as being unpatentable over Iwata in view of Peterson are respectfully requested.

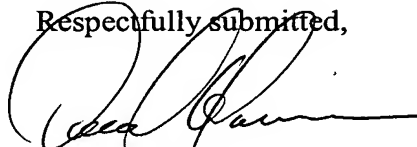
IV. Conclusion

Applicant's representative discussed the above enumerated issues with Examiner Everhart during the May 3 personal interview. The Examiner agreed Applicant's representative's arguments overcame the combination of Iwata with Peterson in the Office Action.

In view of the foregoing, Applicant respectfully submits that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 2, 9-12 and 14-16, in addition to the indicated allowable subject matter of claims 3-8 and 13, are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicant's undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT

Attachment:
Amendment Transmittal

Date: May 20, 2005

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